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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,660	12/05/2005	Kyouhei Koyabu	281730US6PCT	7202
22850	7590	09/20/2010		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER THOMPSON, JAMES A				
ART UNIT		PAPER NUMBER		
2625				
NOTIFICATION DATE		DELIVERY MODE		
09/20/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
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# Office Action Summary

**Application No.**

10/559,660

**Applicant(s)**

KOYABU, KYOUHEI

**Examiner**

James A. Thompson

**Art Unit**

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 Dec 2005, 13 March 2008, 07 July 2010.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.  
4a) Of the above claim(s) 1-15 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-10 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 05 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 12/5/05, 3/13/08  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

2. The Information Disclosure Statements of 05 December 2005 and 13 March 2008 have been fully considered and are included with the present action.

### ***Election/Restrictions***

3. Applicant's election without traverse of Invention I, upon which claims 1-10 read, in the reply filed on 07 July 2010 is acknowledged.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1, 2, 4-7, 9 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Miyashita (US-2006/0001912).**

**Regarding claims 1 and 6:** Miyashita discloses a data editing system (**fig. 2 and para. 32 of Miyashita**) comprising: decoding means for decoding encoded material data into decoded material data while extracting additional information from said encoded material data (**para. 40, lines 1-5 of Miyashita – image data is read, encoded watermark is decoded from image data, and embedded history information is extracted**), before extracting unique information from the extracted additional information in order to output a signal constituted by said decoded material data supplemented with said unique information (**para. 45-46 of Miyashita – time-sorted history information obtained from extracted history information using write position flags**); database means for storing into a database said unique information in correspondence with predetermined processing parameter information (**fig. 3; para. 34; para. 40, lines 6-10; and para. 46 of Miyashita – information regarding apparatuses used for forgery, along with flags for time-serially sorting the apparatuses, is stored in the history information database each time a new copy or print is made**); and editing means for performing predetermined editing on said signal output by said decoding means while acquiring from said database means the processing parameter information corresponding to said unique information for use in said editing (**para. 40 of Miyashita – history information, or lack thereof, is obtained from extracted information and additional history information is added**).

Further regarding claim 6: The method of claim 6 is performed by the system of claim 1.

**Regarding claims 2 and 7:** Miyashita discloses encoding means for encoding said signal edited by said editing means while acquiring from said database means said processing parameter information corresponding to said unique information for use in said encoding (**para.**

**40 of Miyashita** – *history information, or lack thereof, is acquired from extracted information, additional history information is encoded into the image, and the resultant image is output).*

**Regarding claims 4 and 9:** Miyashita discloses wherein said processing parameter information which corresponds to said unique information and which is stored in said database is a decoding parameter used in the decoding performed by said decoding means (**para. 45 of Miyashita** – *write position flags are used to decode the history information and time-serially display the history information).*

**Regarding claims 5 and 10:** Miyashita discloses wherein said processing parameter information which corresponds to said unique information and which is stored in said database is an editing parameter used in the editing performed by said editing means (**fig. 3; para. 40; and para. 46 of Miyashita** – *Processing parameter information is used to determine the time-serial order of the history information and to determine if there is any encoded history information. If there is no history information, new history information is written. If there is history information, additional history information is added.*).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- a. Determining the scope and contents of the prior art.
- b. Ascertaining the differences between the prior art and the claims at issue.
- c. Resolving the level of ordinary skill in the pertinent art.
- d. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**7. Claims 3 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyashita (US-2006/0001912) in view of Iwagaki (US-2003/0161468).**

**Regarding claims 3 and 8:** Miyashita does not disclose expressly wherein said processing parameter information which corresponds to said unique information and which is stored in said database is a compression parameter previously included in said additional information extracted by said decoding means.

Iwagaki discloses wherein said processing parameter information which corresponds to said unique information and which is stored in said database is a compression parameter previously included in said additional information (**para. 67, lines 5-18 of Iwagaki – files management includes storing additional information regarding the compression parameters used to compress the files**).

Miyashita and Iwagaki are analogous art because they are from similar problem solving areas, namely how to manage various information regarding digital data files. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include a compression parameter as a part of the additional information. Thus, by combination with Miyashita, the compression parameter is previously included in said additional information

extracted by said decoding means. The suggestion for doing so would have been that various processing data is stored in the watermark taught by Miyashita. Including the compression parameter would aid in decoding the image data and determining the type of processing performed upon the image data during any possible forgery attempts. Therefore, it would have been obvious to combine Iwagaki with Miyashita to obtain the invention as specified in claims 3 and 8.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tian et al., US-7,187,780, Patented 06 March 2007, Filed 13 December 2002.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Thompson whose telephone number is (571)272-7441. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A Thompson/  
Primary Examiner, Art Unit 2625

12 September 2010